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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.				
10/572,772	03/21/2006	Craig W. Lindsley	21370P	9436				
210 MERCK AND CO., INC P O BOX 2000 RAHWAY, NJ 07065-0907	7590 03/13/2008		<table border="1"><tr><td colspan="2">EXAMINER</td></tr><tr><td colspan="2">HAYLIN, ROBERT H</td></tr></table>		EXAMINER		HAYLIN, ROBERT H	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/572,772

Applicant(s)

LINDSLEY ET AL.

Examiner

ROBERT HAVLIN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-35 is/are pending in the application.
- 4a) Of the above claim(s) 34 and 35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of the claims: Claims 21-35 are currently pending.

Priority: This application is a 371 of PCT/US04/30482 (09/17/2004) which claims benefit of 60/505,035 (9/23/2003).

Response to Applicant Remarks

Claim Rejections - 35 USC § 102

1. Claims 21-33 were rejected under 35 U.S.C. 102(b) as being anticipated by Simay et al. (HCAPLUS abstract with accession number 1981:442979 of Acta Chimica Academiae Scientiarum Hungaricae (1980), 105(2), 127-39).



Simay et al. teaches the compound: which anticipated the elected species.

Applicant argues that the compound taught in the prior art are not effective for the instantly claimed purpose. This is not a requirement for anticipation under 102, specifically MPEP 2121 states:

A prior art reference provides an enabling disclosure and thus anticipates a claimed invention if the reference describes the claimed invention in sufficient detail to enable a person of ordinary skill in the art to carry out the claimed invention; "proof of efficacy is not required for a prior art reference to be enabling for purposes of anticipation." Impax Labs. Inc. v. Aventis Pharm. Inc., 468 F.3d 1366, 1383, 81 USPQ2d 1001, 1013 (Fed. Cir. 2006). See also MPEP § 2122.

Thus, the question of whether Simay discloses the compound as useful for treating schizophrenia in a patient is irrelevant.

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Applicant also argues that Simay is not enabling and one of ordinary skill in the art would be unable to prepare the compound based on the disclosure. The MPEP in section 2121 states:

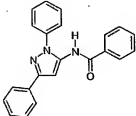
A reference contains an "enabling disclosure" if the public was in possession of the claimed invention before the date of invention. "Such possession is effected if one of ordinary skill in the art could have combined the publication's description of the invention with his [or her] own knowledge to make the claimed invention." In re Donohue, 766 F.2d 531, 226 USPQ 619 (Fed. Cir. 1985).

Thus, the question is whether one of ordinary skill in the art has knowledge of how to make substituted pyrazoles. Simple synthetic transformations such as the addition of phenyl groups and benzamide to a pyrazole core is well known in the art of synthetic chemistry. For example, 1,3-dicarbonyl reactions with hydrazine phenylhydrazine are readily used to produce a variety of pyrazoles. Similarly, acid chloride acylations are among the most common means of attaching acyl groups such as benzyl and phenyl.

In addition, the instant specification relies on the same knowledge of those of ordinary skill in the art to make their own invention. For example page 28 of the specification explains how the compounds of the instant invention are prepared using "standard manipulations ... as may be known in the literature..." and "manipulations ... commonly known to those skilled in the art." The instant application's reliance on the abilities of one skilled in the art of organic synthesis is further exemplified on page 30:

Compounds in Table 1 were synthesized as shown in Reaction Scheme 1, but substituting the appropriately substituted acid chloride as described in Scheme 1 and 2. The requisite starting materials were commercially available, described in the literature or readily synthesized by one skilled in the art of organic synthesis.

Table 1

Compound	Nomenclature	MS M+1
	<i>N</i> -(1,3-diphenyl-1H-pyrazol-5-yl)benzamide	340.4

Therefore, one of ordinary skill in the art could have combined the description of the elected species in Simay with their knowledge to make the claimed invention. Thus, the claims are anticipated and the rejection maintained.

Conclusion

All claims are rejected. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Havlin whose telephone number is (571) 272-9066. The examiner can normally be reached on Mon. - Fri., 7:30am-5pm EST.

If attempts to reach the examiner by telephone are unsuccessful the examiner's supervisor, Joe McKane can be reached at (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert Havlin/
Examiner, Art Unit 1626

/Rebecca L Anderson/
Primary Examiner, Art Unit 1626